

REMARKS/ARGUMENTS

Claims pending in this application are Claims 1-62. The body of the specification and Claims 2 and 44 has been amended to correct informalities. Claims 4-42 and 46-62 have been withdrawn. Accordingly, upon entry of these amendments, Claims 1-3 and 43-45 will be before the Examiner for consideration.

Specification Objections

1. The Examiner has objected to the specification because of the following informalities: The term “dinitrazaundecanoate” is misspelled in the claims and the body of the specification. Replacement paragraphs in the body of the specification: (page 9, lines 3-20 and page 14, lines 3-10), include the correct spelling of “dinitrazaundecanoate.” Claims 2 and 44 have been also been amended to correct the spelling of “dinitrazaundecanoate.” The Applicants appreciate and thank the Examiner for pointing out such corrections.

35 U.S.C. § 103(a) Rejection

2. The Examiner has rejected Claims 1-3 and 43-45 under 35 U.S.C. §103(a) as being unpatentable over Highsmith et al., (U.S. Pat. No. 6,362,331 B1 hereinafter referred to as the ‘331 reference) in view of Day et al., (U.S. Pat. No. 4,916,206 hereinafter referred to as the ‘206 reference) and Wood et al., (U.S. Pat. No. 6,074,581 hereinafter referred to as the ‘581 reference). Applicants respectfully traverse the §103(a) rejections.

The Office Action states that the “[I]t would have been obvious at the time that the invention was made to incorporate DNUDA(ORP) into the minimum-smoke propellant of Highsmith et al., because Highsmith et al., discloses that energetic binders generally may be added, and Day et al., teaches that DNUDA is a useful energetic binder in propellants.” And further, the Office Action states that it would have been obvious at the time that the invention was made to use the prills of Wood et al., in the minimum-smoke propellants of Highsmith et al., because Highsmith et al., discloses that ADN is

useful therein, and Wood et al., teaches a method of making prills of the recited diameter which are made safely and may be stabilized for safety reasons.

Combining the factual inquires set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) and later endorsed by *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992), indicates that a prima facie case of obviousness is established when the Examiner provides the following elements:

1. One or more references
2. that were available to the inventor and
3. that teach
4. a suggestion or combine or modify the references,
5. the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art.

Accordingly, an applicant who is able to prove that the Examiner has failed to establish any one of these elements should prevent the prima facie case of obviousness from being established. Thus, in elements 1 and 2 “references available to the inventor,” prior art cited by the Examiner must include all references each with effective dates before the filing date of the Applicant’s invention. If the Examiner cites prior art that was not available to the public prior to the filing date of the Applicant’s application, a prima facie showing would not be established.

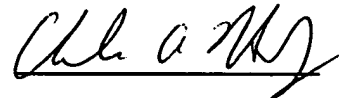
The date the Highsmith reference was publicly available was its issue date of March 26, 2002, which was publicly available after the Applicant’s filing date of March 26, 2001. Since the Examiner has cited Highsmith et al in view of Day et al, and Wood et al, respectfully, the combining of these references is not proper to establish a prima facie case of obviousness, since the Applicants would not have been aware of the Highsmith reference. The Federal Circuit has endorsed this view in *In re Oetiker*, stating that “[i]f the examination at the initial stage does not produce a prima facie case of unpatentability, then without more the [A]pplicants are entitled to grant of the patent.” If Applicants have been successful in its arguments, Applicants respectfully request the Examiner to expand the search to include dependent Claims 4-10, which have been previously withdrawn. Respectfully, reconsideration of Claims 1-3 and 43-45, expanding the Examiner search to include Claims 4-10, and withdrawal of this ground for the §103(a) rejections is requested.

The Commissioner is authorized to charge any fees associated with filing of this response and petition for extension to Deposit Account No. 50-0931.

Applicants submit that all grounds for rejection of claims presented herein have been addressed and amended as such. Accordingly, Claims 1-3 and 43-45 will be before the Examiner for prosecution on the merits and expansion of the Examiner's search to include Claims 4-10 is respectfully requested..

Applicants invite the Examiner to call the undersigned if clarification is needed on any aspect of this response, or if the examiner believes a telephonic interview would expedite the prosecution of the subject application to completion.

Respectfully Submitted,



CHARLENE A. HALEY
Attorney for Applicant
Registration No. 52,983

Navy Case No. 82912
NAWCWD
Office of Counsel, Code K00000D
1 Administration Circle, STOP 1009
China Lake, CA 93555-6100
Telephone: (760) 939-4177
Facsimile: (760) 939-0679